REMARKS

This paper is submitted in reply to the Office Action dated May 2, 2006 within the three-month period for response.

In the subject Office Action, claims 1-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by 6,023,702 (hereinafter "Leisten"). Additionally, in the subject office action, a quotation from 35 U.S.C. § 103(a) was provided as the basis for all obviousness rejections in the Office Action. Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. Because applicants are not certain whether the Examiner intended to reject the pending claims based on 102(b) or 103(a), applicants provide remarks regarding both anticipation and obviousness.

Applicants note that claim 1 recites in part "automated selection means for incorporating data associated with the user-selected attribute into at least one aspect of said contract document; and a document generation means for creating the aspect of the contract document."

With reference to the Office Action, the Examiner asserted that

Leisten does not...specifically teach using the system to create a contract. Leisten does teach using the system for project management. It would have been obvious to one of ordinary skill in the art to use the system as disclosed by Leisten for creating a contract, as making a contract is a project. It further would have been obvious to include a "document generation means" (printer) as it is very well known in the art to connect a printer to a computer and to print out the results of work done on the computer.
Office Action at 3.

Regarding anticipation, applicants submit that, even if the above assertion were accepted, Leisten would not anticipate claim 1 because Leisten admittedly does not teach an automated selection means for incorporating data associated with the user-selected attribute <u>into at least one aspect of said contract document</u>; and a document generation means for <u>creating the aspect of the contract document</u>, and, for a reference to anticipate a claim, the reference must either expressly or inherently teach each limitation of that claim.

Furthermore, applicants traverse that the teaching of Leisten can be applied to creating a contract because "making a contract is a project" since Leisten clearly states that

> These views and user functions always define, plan, and control the progress of work, but mostly *do not affect the actual manual work by people or machines in the currently discussed concepts.* Or in other terms, the process and project management system here discussed does not control how a bricklayer lays the bricks, or uses a bricklaying machine, but rather when according to the overall project plan he has to lay how many bricks in how many hours.
> Col. 19, ll. 51-58.

while the present claims are directed to an invention which *does* change the actual work done in creating a contract by automating the process of creating one or more aspects of an architectural contract document.

Regarding obviousness, applicants note that in order to present a prima facie case of obviousness there must be some suggestion or motivation to modify a reference or to combine reference teachings, there must be a reasonable expectation of success, and the prior art reference must teach or suggest all the claim limitations.

With reference to the Office Action, applicants submit that there is no suggestion to modify the teachings of Leisten to include an automated selection means for incorporating data associated with the user-selected attribute into at least one aspect of said contract document; and a document generation means for creating the aspect of the contract document because, as set forth above, Leisten specifically teaches away from an invention which changes the way the actual work of creating a contract document is performed. Consequently, applicants respectfully submit that claim 1 meets the requirements for patentability set forth in 35 U.S.C. §§ 102(b) and 103, request that the rejection of that claim be withdrawn, and that that claim be reconsidered and allowed.

Turning to independent claim 2, applicants note that that claim recites the limitations of automated selection means for incorporating data associated with the user-selected attribute into at least one aspect of said contract document; and generation means for creating the aspect of the

contract document. Applicants submit that, for the reasons set forth regarding claim 1, those limitations are sufficient to distinguish claim 2 from Leisten.

Furthermore, independent claim 2 recites <u>at least one remote attribute information storage means, comprising a database</u> from which the user-selected attribute is identified, a limitation which is not taught or suggested in Leisten.

With reference to the subject Office Action, the Examiner indicates that Leisten discloses "a remote attribute information storage means (individual workstations, 1021-1026)." However, applicants submit that the individual workstations of Leisten do not teach or suggest remote attribute information storage means because Leisten is clear that all static definitions and dynamic execution values for the projects in an enterprise are stored in a work process object on a *central* computer system. *See* Leisten col. 25, ll. 21-28. Leisten therefore does not disclose, teach or suggest "at least one <u>remote attribute information storage means</u> from which the user-selected attribute is identified." Consequently, applicants respectfully submit that claim 2, as well as claim 3 which depends therefrom, meets the requirements for patentability set forth in 35 U.S.C. §§ 102(b) and 103. They request that the rejection of those claims be withdrawn, and that those claims be reconsidered and allowed.

Turning to independent claim 4, that claim recites in part <u>at least one remote attribute information storage means, comprising a database</u> from which the user-selected attribute is identified, each attribute having a unique identifier and data associated with it. Therefore, for the reasons described above for the similar limitations in claim 2, Leisten fails to disclose the features recited in claim 4, and thus claim 4 should be allowed. Consequently, reconsideration of the rejection of claim 4 and allowance of claim 4, as well as claim 5 which depends therefrom, is respectfully requested.

Turning to independent claim 6, that claim recites in part an automated selection means for incorporating data associated with the selected attribute <u>into at least one aspect of a contract document</u> and a generation means for <u>creating the aspect of the contract document</u>. Applicants submit that, for the reasons set forth regarding claim 1, those limitations are sufficient to distinguish claim 6 from Leisten.

Furthermore, applicants note that claim 6 recites the limitations of "the data entry means comprising a graphical user interface having text entry and drop-down menu choices."

With regard to the subject Office Action, applicants note that those limitations from claim 6 were simply not addressed, and that the only treatment of any data entry means or graphical user interface was provided regarding claim 1. That treatment reads: "Leisten discloses…data entry means (keyboard), which would inherently use a graphical user interface as it is done on a computer." Applicants note that, even assuming that a keyboard is a data entry means, a keyboard does not inherently teach a graphical user interface having both text entry and drop down menu choices. Consequently, applicants request that the rejection of claim 6 be withdrawn, and that that claim be reconsidered and allowed.

Turning to claim 7, that applicants note that that method claim is significantly more detailed than the system claims 1-6 and that, even if Leisten did teach or suggest every limitation in claims 1-6, it would be necessary to independently address claim 7, because that claim recites limitations not found in claims 1-6.

With respect to the subject Office Action, the entirety of the treatment provided for claim 7 is as follows:

> As to claim 7, Leisten discloses a system as discussed above. Leisten further
> teaches maintaining an association between each of a plurality of pieces of
> selectable design information (plans for the project), it would be obvious to one of
> ordinary skill in the art to allow the user to choose attributes, and to store those
> attributes for retrieval, as the system is shown to help the process and not perform
> it autonomously it would further be obvious to store results so the project could be
> worked on through successive times and not be required to do the whole project at
> one time.

Applicants note that that discussion simply does not address several limitations recited in claim 7. For example, it does not address the step of "generating one or more aspects of said contract document in one or more of a plurality of formats by accessing the association of the one or more aspects with stored user selected attributes in the user database" which differs from the limitations recited in claims 1-6 in that it recites that generating one or more aspects of a contract document is done by accessing the association of the one or more aspects with stored user

selected attributes in the user database, limitations neither addressed in the subject Office Action nor taught or suggested in Leisten. Similarly, applicants note that the subject Office Action did not address the limitations of "graphically displaying a data entry form populated by the filtered associated information." It further did not address the limitations of "referencing a unique identifier for each attribute and information associated with said respective unique identifier." It further did not address the limitations of "maintaining an association between each of a plurality of pieces of selectable design information for a building and a respective data entry location in one or more of the schedule aspect and the specification aspect." Having reviewed Leisten, applicants assert that none of those limitations are either taught or suggested in that reference. Consequently, applicants request that the rejection of claim 7, along with the rejections of claims 8-15 which depend therefrom, be withdrawn, and that those claims be reconsidered and allowed.

General Remarks

In future actions, in order to provide applicants with the opportunity to present evidence and arguments in favor of patentability, applicants respectfully request that the Examiner address each limitation in the pending claims, and explicitly set out the particular passages of Leisten or other references which allegedly teach or suggest those limitations. Applicants submit that the above discussion does not constitute an exhaustive list of the novel limitations found in claims 1-15 which are not taught or suggested in the prior art of record. To the extent that applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, applicants reserve all rights with respect to arguments not explicitly raised herein.
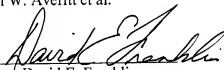
Conclusion

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, David Franklin at (513) 651-6856 or dfranklin@fbtlaw.com.

Although no new fees are due, the Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.
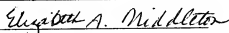
Respectfully submitted,

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I hereby certify that a copy of this correspondence is being deposited with the US Patent Office by electronic transmission addressed to MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

_____July 20, 2006_____

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